



7020-02

INTERNATIONAL TRADE COMMISSION

[Investigation No. 337-TA-1088]

Certain Road Construction Machines and Components Thereof; Commission Final

Determination Finding a Section 337 Violation; Issuance of a Limited Exclusion Order and a Cease and Desist Order; Termination of the Investigation

AGENCY: U.S. International Trade Commission.

ACTION: Notice.

SUMMARY: Notice is hereby given that the U.S. International Trade Commission has found a violation of section 337 of the Tariff Act of 1930 (“section 337”), as amended, in this investigation. The Commission has issued a limited exclusion order (“LEO”) prohibiting the importation by respondents Wirtgen GmbH, Wirtgen Group Holding GmbH (“Wirtgen Group”), and Wirtgen America, Inc. (“Wirtgen America”) of certain road construction machines and components thereof that infringe claim 19 of U.S. Patent No. 7,140,693. The Commission has also issued a cease and desist order (“CDO”) directed to respondent Wirtgen America. The investigation is terminated.

FOR FURTHER INFORMATION CONTACT: Houda Morad, Office of the General Counsel, U.S. International Trade Commission, 500 E Street SW., Washington, DC 20436, telephone (202) 708-4716. Copies of non-confidential documents filed in connection with this investigation are or will be available for inspection during official business hours (8:45 a.m. to 5:15 p.m.) in the Office of the Secretary, U.S. International Trade Commission, 500 E Street SW., Washington, D.C. 20436, telephone (202) 205-2000. General information concerning the Commission may also be obtained by accessing its Internet server at <https://www.usitc.gov>. The public record for this investigation may be viewed on the Commission’s electronic docket (EDIS)

at <https://edis.usitc.gov>. Hearing-impaired persons are advised that information on this matter can be obtained by contacting the Commission's TDD terminal on (202) 205-1810.

SUPPLEMENTARY INFORMATION: The Commission instituted this investigation on November 29, 2017, based on a complaint, as supplemented, filed by Caterpillar Inc. of Peoria, Illinois and Caterpillar Paving Products, Inc. of Minneapolis, Minnesota (collectively, "Complainants"). *See* 82 FR 56625-26 (Nov. 29, 2017). The complaint, as supplemented, alleges violations of section 337 of the Tariff Act of 1930, as amended (19 U.S.C. 1337), based upon the importation into the United States, the sale for importation, and the sale within the United States after importation of certain road construction machines and components thereof by reason of infringement of certain claims of U.S. Patent Nos. 7,140,693 ("the '693 patent"); 9,045,871 ("the '871 patent"); and 7,641,419 ("the '419 patent"). *See id.* The notice of investigation identifies the following respondents: Wirtgen GmbH of Windhagen, Germany; Joseph Vögele AG of Ludwigshafen, Germany; Wirtgen Group of Windhagen, Germany; and Wirtgen America of Antioch, Tennessee. *See id.* The Office of Unfair Import Investigations is not a party to this investigation. *See id.*

The ALJ terminated the '871 patent from the investigation after finding the asserted claims of that patent to be invalid under 35 U.S.C. § 101. *See* Order No. 18 (May 24, 2018), *previously reviewed*, Comm'n Notice (July 3, 2018). The Commission terminated the '419 patent from the investigation after Complainants withdrew their allegations with respect to that patent. *See* Order No. 26 (July 5, 2018), *unreviewed*, Comm'n Notice (July 25, 2018). The Commission also terminated claim 25 of the '693 patent from the investigation after Complainants withdrew their allegations as to that claim. *See* Order No. 38 (Oct. 16, 2018), *unreviewed*, Comm'n Notice (Nov. 9, 2018).

On February 14, 2019, the ALJ issued the FID finding a violation of section 337 by certain accused products by reason of infringement of claim 19 of the '693 patent. In addition, the FID finds all the asserted claims, except claim 19 of the '693 patent, to be invalid as anticipated and/or obvious over the prior art. Furthermore, the FID finds that Complainants have satisfied the domestic industry requirement with respect to the '693 patent. The ALJ also issued a recommended determination ("RD") recommending that the Commission issue an LEO against the infringing products and a CDO against each respondent. The ALJ further recommended against setting a bond during the period of Presidential review.

On April 12, 2019, the Commission issued a Notice determining to review the FID in part. *See* 84 Fed. Reg. 16282-83 (Apr. 18, 2019). The Commission's notice solicited written submissions on remedy, the public interest, and bonding. On April 30, 2019, the parties filed written submissions in response to the April 12, 2019 Notice, and on May 10, 2019, the parties filed responses to each other's submissions.

Having examined the record of this investigation, including the FID, the RD, and the parties' submissions, the Commission has determined to affirm with modification the FID's ultimate conclusion of a section 337 violation with respect to claim 19 of the '693 patent. In addition, as explained in the Commission Opinion filed concurrently herewith, the Commission has determined to modify the FID's findings with respect to: (1) the construction of the claim term "a retracted position relative to said frame"; (2) the infringement of the asserted method claims, *i.e.*, claims 17-19, 24, 26-28, and 38 of the '693 patent; (3) the invalidity of claims 1, 15-18, 24, 26, 27, 36, and 38 of the '693 patent over Volpe SF-100 T4 in view of U.S. Patent No. 3,633,292 (Ulrich); (4) no invalidity of claims 1, 15-19, 24, 26-28, 36, and 38 of the '693 patent over U.S. Patent No. 3,843,274 (Gutman) alone or in combination with other prior art; and (5) no

invalidity of claim 19 over Volpe SF-100 T4 in view of Ulrich and WO 97/42377 (Busley). All findings in the FID that are not inconsistent with the Commission's determination are affirmed.

The Commission has also determined to affirm the ALJ's initial determination (Order No. 18) terminating the '871 patent from the investigation based on the invalidity of the asserted claims of that patent under 35 U.S.C. § 101. Commissioner Schmidlein dissents from the Commission's decision to affirm Order No. 18 and has filed a separate dissenting opinion.

Accordingly, the Commission finds that there is a violation of section 337 with respect to claim 19 of the '693 patent. The Commission has determined that the appropriate remedy is a limited exclusion order against Wirtgen Group, Wirtgen GmbH, and Wirtgen America's infringing products, and a cease and desist order against Wirtgen America. The Commission has also determined that the public interest factors enumerated in subsections 337(d)(1) and (f)(1) (19 U.S.C. 1337(d)(1), (f)(1)) do not preclude the issuance of the limited exclusion order and cease and desist order. The Commission has further determined to set a bond at zero (0) percent of entered value during the Presidential review period (19 U.S.C. 1337(j)).

The Commission's orders and opinion were delivered to the President and to the United States Trade Representative on the day of their issuance.

The authority for the Commission's determination is contained in section 337 of the Tariff Act of 1930, as amended (19 U.S.C. 1337), and in part 210 of the Commission's Rules of Practice and Procedure (19 CFR part 210).

By order of the Commission.

Issued: June 27, 2019.

Lisa Barton,

Secretary to the Commission.

[FR Doc. 2019-14189 Filed: 7/2/2019 8:45 am; Publication Date: 7/3/2019]